

By the present amendment, the title has been amended to correct a formal error therein. The specifications has been amended to correct a lexical error therein (a mark-up copy of a respective paragraph is enclosed). Claims 1-12 have been cancelled. Claims 13-25 have been added.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

I. Rejection of Claims Under 35 U.S.C. § 112

The Examiner rejected claims 1-12 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. As noted above, claims 1-12 have been canceled. It is respectfully submitted that the new claims 13-25 comply with all of the requirement of 35 U.S.C. § 112.

II. Rejection Over the Prior Art

The Examiner rejected claims 1-4, 6-8, and 10-12 under 35 U.S.C. § 103(a) as being unpatentable over Taylor, U.S. Patent No. 2,810,672 (Taylor) in view of Stockl, U.S. Patent No. 3,699,926 (Stockl). Claims 5 and 9 were rejected as claims above and further in view, respectively, of Myrvold, U.S. Patent No. 5,619,832 (Myrvold) and Dungle, U.S. Patent No. 4,329,981

(Dungle). It is respectfully submitted that claims 13-25 are patentable over the cited references.

Specifically, claim 13 recites that the third projections have a height smaller than a height of the second projections. Thereby, the third projections provide for additional support of the covering on the floor when the load applied to the covering exceeds a predetermined value. The foregoing novel features of the present invention is not disclosed or suggested in the prior art, including all of the prior art of record in this application.

Considering the prior art, Taylor discloses a two-part floor mat for automobiles. The floor mat of Taylor consists of two mats a cover mat (12) and a bottom mat (10) that has a flat underside contacting the floor. Taylor does not disclose or even remotely suggests that the cover mat (12) can be used separately from the bottom mat (10). Even assuming, *arguendo*, that it could be used separately, it still differs from the floor covering according to the present invention. Specifically, the nibs (15) are not arranged between the lugs (13) are not designed to provide any support for the mat (12).

Stockl and other secondary references likewise do not disclose the novel features of the present invention, as defined by claim 13.

It is to be pointed out that Taylor and Stockl disclose completely different floor coverings. Whereas Taylor discloses a floor mat (covering) for automobile, Stockl discloses a mat (covering) for animals, and their intended functions are completely different. Even if it would have been obvious to combine Taylor and Stockl, as suggested in the Office Action, the combination would still lack the arrangement of the third projections between the second projection and which are designed for supporting the floor covering on floor.

Since all claim limitations must be considered in an obviousness determination, and since the combination of Taylor and Stockl fails to disclose several of the important and recited elements and features of independent claim 13, it is respectfully submitted the present invention, as defined by claim 13, is not rendered obvious by the combination of Taylor and Stockl and is, therefore, patentably defines over said combination.

However, it is respectfully submitted that a *prima facie* case of obviousness has not been made. Even if Taylor and Stockl could be construed to disclose certain matter as contended by the Examiner, no disclosure or suggestion in either Taylor and Stockl can be found which should lead a skilled artisan to combine their various features. That separate features of different

references may not properly be convinced, in the absence of some specific teaching that they should or could be so combined, is such well-settled law that it hardly need be repeated here. See, e.g., In re Newell, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1989), citing Smithkline Diagnostis v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988). In order to properly combined references to reach the conclusion that the claimed subject matter as a whole would have been obvious, there must have been some teaching, suggestion, or inference in either reference, or both, which would have led one of ordinary skill to combine the relevant teaching of the references. ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). No such teaching, suggestion or inference could be found in any of Taylor and Stockl.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior art should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obvious.” In re Spinnoble, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious. Moreover, it is respectfully submitted that taking the cover mat (12) alone, whereas the floor mat of Taylor is designed to be used as a unit, is a matter of hindsight reconstruction.

In view of the above, it is respectfully submitted that claim 13 patentably defines over the prior art and is, therefore allowable.

Claims 14-25, depend on claim 13 and are allowable for the same reason claim 13 is allowable and further because of specific features recited therein which, when taken above and/or in combination with features recited in claim 13, are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,

Alexander Zinchuk
Y. ALEXANDER ZINCHUK, Reg. No. 30,541
David Toren
Reg. No. 19,468

Dated: July 15, 2002
Sidley Austin Brown & Wood LLP
787 Seventh Avenue
New York, N.Y. 10019
Tel.: (212) 839-7365

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Commissioner for Patents, Washington, DC 20231 on July 15, 2002.

Alexander Zinchuk

Version with Marking Showing Changes Made

Second projections 35 in the form of flat square prisms with rounded edges and corner areas are provided on the underside of the covering in the interstices between the first projections 33. Furthermore, third projections 37 are provided on the underside of the covering diagonally between these second projections 35 and aligned with the central axis of the first projections 33. In this case also, they have the shape of flat square prisms, but smaller lateral measurements and a slighter height of the second projections 35, so that they only touch the floor in the case of a load and, in addition, act as a cushion.

The scope of the invention is not limited to the examples described above, but a number of variations are also possible for one skilled in the art. In particular, the geometric shapes, measurements and grid sizes of the first, second and third projections can be combined and varied in numerous ways to adapt to the actual intended use and the load requirements of the floor covering as well as to obtain preset cushioning characteristics.

In a special further development of the basic idea of the invention, which can be seen with reference to Fig. 5, the floor covering has openings 8 (perforations) or ^{recesses} ~~rebounds~~ 9 provided in the underside of the covering in which the thickness of the covering is reduced locally. A further distinguished setting of the elastic properties of the floor covering can be obtained, on the one hand, with these special embodiments and, especially in the case of perforations, the flow-off of

09745645 122200

water (or other liquid) that might have collected on the top of the covering. The additional perforations 8 or ^{recesses} ~~rebounds~~ 9 can be especially easily shown in circular form, however, they can also have an elongated form following the path of the interstices between the first and second projections of the floor covering. A form elongated in this way especially also comprises circular segments, however, it can also be closely adapted to the shape of the interstices. ✓

002221-54954260